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CENTRAL REEXAMINATION UNIT

In re Application of
Niro Nakamichi et al
Application No. 08/760,706
Filed: December 5, 1996
Atty. Docket No.: 004076.73577

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: ORDER TO
: SHOW CAUSE
:
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The above-captioned reissue proceeding (the '706 proceeding) was referred to the Office of Patent Legal Administration (OPLA) on May 26, 2006.

This is a show cause order based upon the expiration of U.S. patent 5,123,001, for which the present application requests reissue.

BACKGROUND

1. The present application was filed December 5, 1996, for reissue of U.S. patent 5,123,001 (the '001 patent) issued January 29, 2002.
2. On October 8, 2004, applicants filed a response to the Office communication of September 10, 2004. This was the last paper entered into the record of the '706 reissue proceeding.
4. The Office's financial records reveal that the 11.5 year maintenance fee due by June 16, 2004 (the end of the grace period), was not paid.
5. The *Official Gazette* provided notification that the '001 patent expired on June 16, 2004, for failure to pay the 11.5 year maintenance fee due. See 1285 *Official Gazette* 49, 50 (August 10, 2004).

ORDER TO SHOW CAUSE

As pointed out above, the present reissue proceeding is for reissue of the '001 patent, and that patent expired on June 16, 2004, for failure to pay the 11.5 year maintenance fee. On August 10, 2004, a Notice of the expiration of the '001 patent was published in the *Official Gazette*. Since the '001 patent has expired for failure to pay the third maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '001 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, **when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority** because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the application for reissue of the '001 patent to be an abandoned application.

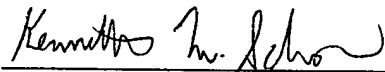
Applicant is hereby being provided with a period of **30 DAYS** from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.

If applicant proposes to show cause why the present reissue proceeding should not be terminated, applicant's showing must include an explanation of why the proceeding should continue in spite of the expiration of the original patent revealed by the Office's records.

If applicant makes a showing, the showing will be evaluated as to whether it provides sufficient basis why the present reissue proceeding should not be terminated. A failure to respond to this show cause order within the 30 day period that has been set will result in the proceeding being terminated by default. If the present reissue proceeding is terminated, the application for reissue of the '001 patent will be returned to Technology Center 2600 for processing as an abandoned application.

CONCLUSION

1. Applicant is being provided with a period of 30 DAYS from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding.
2. Failure by applicant to respond to this show cause order within the 30 day period that has been set will result in termination of the proceeding by default, followed by a mailing of a Notice of Abandonment in the application for reissue of the '001 patent.
3. The file for reissue application 08/760,706 is being retained in the Office of Patent Legal Administration, pending a response by applicant, or the expiration of time for a response.
4. Telephone inquiries related to this decision should be directed to Karen Hastings, Legal Advisor, at (571) 272-7717 or, in her absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

kmh
July 2, 2006

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